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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/559,666	12/05/2005	Takao Shibata	Q91463	7227
23373 7590 01/09/2009 SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037				
EXAMINER				
MULLS, JEFFREY C				
ART UNIT		PAPER NUMBER		
1796				
MAIL DATE		DELIVERY MODE		
01/09/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/559,666

Applicant(s)

SHIBATA ET AL.

Examiner

Jeffrey C. Mullis

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4 and 5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4 and 5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

The amendment filed 12-5-05 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The specification as filed does did not disclose that the applications in the first line of the specification were incorporated by reference.

Applicant is required to cancel the new matter in the reply to this Office Action.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyatake et al. (US 2003/0092819).

Patentees disclose a process in which polymerization of vinyl monomers (as in applicants vinyl monomer "C") is conducted in the presence of a silicone latex (i.e. grafted) with 5-40 parts monomer (paragraph 80). The silicone latex may contain 0-40% graftlinker or preferably 0.5-20% (paragraph 41).

No examples exist in which all of applicants limitations are present in combination. However, to arrive at applicants composition by selecting from the various choices of the patent would have been obvious to a practitioner having an ordinary skill in the art at

the time of the invention in the expectation of adequate results basement any showing of surprising or unexpected results.

Applicant's arguments filed 10-23-08 have been fully considered but they are not persuasive.

Paragraphs 15-17 of the reference Miyatake implies that in some instances each particle of graft substrate contains both silicone and acrylate rubber and in fact in some instances the silicone and acrylate rubber are actually bonded chemically. Hence at least in some instance the silicone rubber can be said to contain polyacrylate. Miyatke hence disclose more than one embodiment with regard to the type of rubber substrate used. In any case Miyatakes' disclosure at paragraph 15 that the silicone and acrylate need to "physically coexist" when one of them contains no graft sites implies that the acrylate and silicone graft bases may be separate in some embodiments. Applicants argue that consisting essentially of excludes the acrylate component of the reference. However, the term "consisting essentially of" only excludes those materials which materially affect the novel and basic characteristics of a composition and it is applicants' burden to prove that such characteristics are changed by the presence of additional materials recited in a prior art product. Note In re Janakirama-Rao, 317 F. 2d 951, 137 USPQ 893 (CCPA 1963) and In re De Lajarte, 337 F. 2d 870, 143 USPQ 256 (CCPA 1964) in this regard. Applicants point to the large amount of acrylate rubber used in the examples. However, Miyatake at paragraph 12 implies that only 10% acrylate need be present. Furthermore page 13, lines 12-17 indicates that acrylate graft rubbers may be present in applicants compositions. Therefore "consisting essentially of" does not

appear to exclude acrylate rubbers. Applicants argue that the concentrations of the instant claims distinguish over the reference. However "86-94.99" parts as recited by the instant claims is based on applicants components A, B and C and if the polybutyl acrylate is viewed as not reading on A, B or C then it is immaterial how much polybutyl acrylate of the reference is present. In any case as set out above Miyatake disclose that as such as 90% silicone may be present in the graft base used. With regard to applicants monomer "B", this corresponds to Miyatakes "graftlinker" (present at a level of 0.5-20%) as set out in paragraph 41 of the reference while Miyatakes monomer of paragraph 80 corresponds to applicants monomer "C" as set out in the above rejection.

Any inquiry concerning this communication should be directed to Jeffrey C. Mullis at telephone number 571 272 1075.

Jeffrey C. Mullis
Primary Examiner
Art Unit 1796

JCM

12-21-08

/Jeffrey C. Mullis/

Primary Examiner, Art Unit 1796